



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

HL

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/692,749	10/20/2000	Sandrine Decoster	05725.0782-00000	7073
22852	7590	10/06/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			YU, GINA C	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	<b>Application No.</b> 09/692,749	<b>Applicant(s)</b> DECOSTER ET AL.	
	<b>Examiner</b> Gina C. Yu	<b>Art Unit</b> 1617	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 26 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☒ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See continuation sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-112.

Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).
10. ☐ Other: \_\_\_\_\_

  
**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**

Continuation of No. 5:

Applicants' remarks were considered but are unpersuasive.

While applicants assert that the present invention has "additional benefits resulting from its additional components", examiner views that obtaining additive effects by combining known components is obvious. The fact that applicant has recognized an advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The experiments in Declaration does not demonstrate that the combination of Dalle or Dubief produces an unexpected results. The only type of silicone in Composition A, applicants' invention, is the Dalle silicone copolymer. While Compositions A and B were compared to show that the Dalle silicone copolymer produces better hair disentangling by 22 %, examiner views that the results are hardly unexpected or surprising. Composition B does not even represent the closest prior art because the use of Dalle silicone copolymer in hair product is expressly taught by the reference. While applicants assert that the teachings of the Dalle reference is "subjective", examiner respectfully points out that the standard of obviousness is an objective test. The objective evidence here, which is the basis of the pending rejection, is the fact that a routineer had knowledge of the beneficial properties of the Dalle silicone copolymer in hair care products. While applicants' panelists favored the Dalle silicone over ABILQUAT 3473 to a certain level, in view of the teachings in Dalle, the test results is hardly viewed unexpected or surprising.

Applicants argue that Dubief '383 teaches "only the possible use of additional silicones that are soluble", examiner respectfully disagrees. The patent teaches and claims a composition comprising "at least one polyorganosiloxanes that are insoluble in aqueous medium". The passage in col. 7, lines 56 – 62 does not imply that no water-insoluble silicone may be added to the composition. The "possible" additives to improve keratinous matters are in no way limited to the exemplified cosmetic agents, "such as cationic surface-active agents, polymers other than the copolymers of diallyldialkylammonium and of an anionic monomer or proteins or else silicones which are soluble in the mixture". These are only examples. The reference sets forth that the condition for suitable additive for the Dubief composition is not whether the additive silicone is water-soluble or –insoluble. The "silicones which are soluble *in the mixture*" is not limited to water-soluble silicones only: silicones that are soluble in the silicone phase should be taken into account also. There is no teaching or suggestion, either expressly or implicitly, that the Dalle silicone copolymer should not be added with the Dubief composition.

In response to applicants' remarks on obviousness double patenting, it was understood by examiners at the time of the interview that the rejection would be held until a terminal disclaimer is filed or allowable subject matter is determined. Examiner also notes that a proper examination practice requires to make the rejection in accordance to the statute.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu  
Patent Examiner

A handwritten signature in black ink, appearing to read 'S. Padmanabhan', with a horizontal line underneath the signature.

**SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER**